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EXAMINER

DINH, MINH

ART UNIT PAPER NUMBER

2132

DATE MAILED: 03/18/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

SR

Office Action Summary

Application No.

09/483,063

Applicant(s)

TOH ET AL.

Examiner

Minh Dinh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed 12/30/2003 that amended the specification and claims 1, 8, 15-17 and 19. Claims 20-25 have been added.

Response to Arguments

2. Applicant's arguments, see page 10, lines 23-27, filed 12/30/2003, with respect to claims 1-19 have been fully considered and are persuasive. The rejection of claims 1-19 has been withdrawn. However, a discovery of new prior art has necessitated new grounds of rejection. The delay in citation of the newly discovered prior art is regretted.

Claim Objections

3. Claims 8 and 25 are objected to because of the following informalities:
 - a. Regarding claim 8, "in loaded" (the last line of the claim) should be changed to "is loaded".
 - b. Regarding claim 25, "only said adding one or more identifiers" (the last line of the claim) should be changed to "only adding said one or more identifiers".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 24-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "after said installing each software product, adding one or more identifiers into the memory" (the last two lines of claim 24) in combination with other limitations of the claim is not described in the original disclosure. According to the original disclosure, for either recovery process or new installation process, a software product can be installed only if its software product identifier matches an identifier stored in the memory; and after the software product is installed, no identifier is added into the memory.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida et al. (6,075,862) in view of Mullor et al. (6,411,941).

a. Regarding claim 1, Yoshida discloses a software delivery system comprising:
a digital storage device containing a software product, said software product having been assigned a unique identifier (fig. 1, item 10); and

a computer system, said computer system having a drive for reading data stored on the digital storage device, a processor, a hard drive (fig. 1), said computer system storing at least one identifier corresponding to the identifier of said software product in the hard drive (fig. 1, item 13);

wherein when said digital storage device is read by said drive, the software product having an identifier which corresponds to the at least one identifier stored in the hard drive is loaded onto said computer system (fig.6 and col. 6, lines 3-11, 27-40).

Yoshida does not disclose using a non-volatile memory to store the identifiers. Mullor discloses using a non-volatile memory to store data regarding software usage authorization (col. 1, lines 48-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system to use a non-volatile memory to store the identifiers, which are software usage authorization data, as taught by Mullor. It would be more difficult to tamper with data stored in a non-volatile memory (col. 3, lines 4-9).

b. Regarding claim 2, Yoshida does not disclose that the non-volatile memory may be updated to include additional identifiers. Mullor further discloses that the non-volatile memory can be updated to include additional records (col. 2, lines 1-5). It would have

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been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that the non-volatile memory may be updated to include additional identifiers, as taught by Mullor. The motivation for doing so would have been that additional software could be used with the computer system.

c. Regarding claim 3, Yoshida does not disclose that the non-volatile memory is read-only memory. Mullor further discloses that the non-volatile memory is read-only memory (col. 1, lines 46-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that the non-volatile memory is read-only memory, as taught by Mullor. The motivation for doing so would have been that data couldn't be removed or modified.

d. Regarding claim 4, Yoshida does not disclose that the identifier in the non-volatile memory is encrypted. Mullor further discloses that the content of the non-volatile memory is encrypted, resulting in a stricter verification method (col. 5, lines 25-27; col. 6, lines 28-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that the identifiers in the non-volatile memory is encrypted, as suggested by Mullor, in order to achieve a stricter verification method.

e. Regarding claim 5, Yoshida does not disclose that the computer system comprises an update module for updating the non-volatile memory to include additional identifiers. Mullor further discloses an update module for updating the non-volatile memory to include more program names, which meets the limitation of software product identifiers (col. 1, lines 53-58; col. 2, lines 1-5). It would have been obvious to one of

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ordinary skill in the art at the time the invention was made to modify the Yoshida system such that it comprises an update module for updating the non-volatile memory to include additional identifiers, as suggested by Mullor. The motivation for doing so would have been that additional software could be used with the computer system.

f. Regarding claim 6, Yoshida further discloses that the software delivery system comprises a serial number stored in the computer system (fig. 4, item 22).

g. Regarding claim 7, Yoshida does not disclose that the serial number is stored in the non-volatile memory. Mullor further discloses that the serial number is stored in a ROM section (col. 1, lines 46-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that the serial number is stored in a ROM section, as suggested by Mullor. The motivation for doing so would have been that the serial number could not be removed or modified.

8. Claims 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Mullor and Stanton et al. (5,058,162).

a. Regarding claim 8, it differs from claim 1 in that the digital storage device contains a plurality of software modules containing at least one software product and that each of the software modules has been assigned a unique identifier. Stanton disclose a digital storage device containing a plurality of software modules containing at least one software product and that each of the software modules has been assigned a unique identifier (col. 3, lines 46-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida such that the digital

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storage device contains a plurality of software modules containing at least one software product and that each of the software modules has been assigned a unique identifier, as suggested by Stanton. The motivation for doing so would have been that significant cost savings could be achieved (col. 1, lines 30-35) and that related software products could be accessed together as a software module (col. 3, lines 46-51; col. 5, lines 14-22).

b. Regarding claim 9, Yoshida does not disclose that the non-volatile memory may be updated to include additional identifiers. Mullor further discloses that the non-volatile memory can be updated to include additional records (col. 2, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that the non-volatile memory may be updated to include additional identifiers, as taught by Mullor. The motivation for doing so would have been that additional software could be used with the computer system.

c. Regarding claim 10, Yoshida does not disclose that the non-volatile memory is read-only memory. Mullor further discloses that the non-volatile memory is read-only memory (col. 1, lines 46-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that the non-volatile memory is read-only memory, as taught by Mullor. The motivation for doing so would have been that data couldn't be removed or modified.

d. Regarding claim 11, Yoshida does not disclose that the identifier in the non-volatile memory is encrypted. Mullor further discloses that the content of the non-volatile memory is encrypted, resulting in a stricter verification method (col. 5, lines 25-

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27; col. 6, lines 28-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that the identifiers in the non-volatile memory is encrypted, as suggested by Mullor, in order to achieve a stricter verification method.

e. Regarding claim 12, Yoshida does not disclose that the computer system comprises an update module for updating the non-volatile memory to include additional identifiers. Mullor further discloses an update module for updating the non-volatile memory to include more program names, which meets the limitation of software product identifiers (col. 1, lines 53-58; col. 2, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that it comprises an update module for updating the non-volatile memory to include additional identifiers, as suggested by Mullor. The motivation for doing so would have been that additional software could be used with the computer system.

f. Regarding claim 13, Yoshida further discloses that the software delivery system comprises a serial number stored in the computer system (fig. 4, item 22).

g. Regarding claim 14, Yoshida does not disclose that the serial number is stored in the non-volatile memory. Mullor further discloses that the serial number is stored in a ROM section (col. 1, lines 46-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that the serial number is stored in a ROM section, as suggested by Mullor. The motivation for doing so would have been that the serial number could not be removed or modified.

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9. Claims 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor (5,894,571) in view of Day et al (6,016,400) and Mullor et al. (6,411,941).

a. Regarding claim 15, O'Connor discloses a process for delivery of custom-ordered software products to a computer system having anticipated elements. The process comprises the steps of:

writing custom-ordered software products onto a digital storage device (col. 4, lines 46-49, col. 5, lines 21-25);

assigning a unique identifier to the digital storage device (col. 6, lines 17-18);

writing the identifier to an internal storage of the computer system (col. 6, lines 14-15, 37-40);

inserting the digital storage device into the computer system (col. 6, lines 29-31);

reading the identifier stored in the computer system (col. 6, lines 37-39);

comparing the retrieved identifier with one assigned to the digital storage device that contains the custom-ordered software products (col. 6, lines 39-40);

installing the custom-ordered software products if the identifiers match (col. 6, lines 40-41);

In the O'Connor reference, the digital storage device contains only the custom-ordered software products, and one identifier is stored and used for verification of all custom-ordered software products for installation. Day discloses a process for delivery of custom-ordered software products to a computer system, which utilizes a digital storage device that contains, in addition to the custom-ordered software products for a computer system, all other software products that can be installed on that particular

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computer system (col. 3, lines 32-36). Day does not disclose that each software product in the storage device is assigned a unique identifier, however, this feature is deemed to be inherent to the Day process because it is able to identify the custom-ordered software products in the storage device and install them onto the computer system (fig. 3, step 116). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of O'Connor such that the digital storage device containing, in addition to the custom-ordered software products for a computer system, all other software products that can be installed on that particular computer system; and that a unique identifier is assigned to each software product in the storage device, as taught by Day. Accordingly the software product identifiers of the custom-ordered software product would be stored and used for installation verification in place of the identifier assigned to the digital storage device. The motivation for doing so would have been that single manufacturing CD ROM (and copies thereof) is employed for preloading each computer system irrespective of the required software configuration for the particular computer system (col. 3, lines 36-39).

O'Connor does not disclose using a non-volatile memory to store the identifiers. Mullor discloses using a non-volatile memory to store data regarding software usage authorization (col. 1, lines 48-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system to use a non-volatile memory to store the identifiers, which are software usage authorization data, as taught by Mullor. It would be more difficult to tamper with data stored in a non-volatile memory (col. 3, lines 4-9).

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b. Regarding claim 16, O'Connor fails to teach that the set of software products is written onto the digital storage device before the custom-ordered software products is ordered. However, Day discloses that a set of software products is written onto the digital storage device before the custom-ordered software products is ordered (col. 2, lines 30-32; col. 3, lines 32-36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of O'Connor such that the set of software products is written onto the digital storage device before the custom-ordered software products is ordered, as taught by Day, to take advantage of the CD ROM already present in the system.

c. Regarding claim 17, O'Connor further discloses that the software products are tested before they are written onto the digital storage device (col. 4, lines 50-55).

d. Regarding claim 18, O'Connor does not disclose that the identifier in the non-volatile memory is encrypted. Mullor further discloses that the content of the non-volatile memory is encrypted, resulting in a stricter verification method (col. 5, lines 25-27; col. 6, lines 28-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that the identifiers in the non-volatile memory is encrypted, as suggested by Mullor, in order to achieve a stricter verification method.

e. Regarding claim 19, O'Connor further discloses the step of checking the serial number of the computer system before installing the custom-ordered software products to the computer system (col. 6, lines 9-12, 37-41), which meets the limitation of

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checking the serial number of the computer system before writing the identifiers of the custom-ordered software product into the non-volatile memory of the computer system.

10. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Beetcher et al. (5,933,497).

a. Regarding claim 20, Yoshida discloses a system comprising:

a processor (fig. 1, item 11);

storage coupled to the processor and containing a plurality of software identifiers (fig. 1, items 12-13);

wherein said system is adapted to receive a removable storage device containing a software product (fig 1, items 100, 103), the software product having an associated software identifier that is unique to each software product (fig1, item 102);

wherein the processor is adapted to install a software product from the removable storage device that has a software identifier that matches a software identifier stored in the system's storage, but not install the software product from the removable storage device that do not has a software identifier that matches a software identifier stored in the system's storage (fig.6 and col. 6, lines 3-11, 27-40).

Yoshida does not disclose that the removable storage device containing more than one software product. Beetcher discloses a removable storage device containing multiple software products (col. 5, line 65 – col. 6, line 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that the removable storage device containing multiple software products,

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as suggested by Beetcher, so that more software products could be distributed on one removable storage device.

b. Regarding claim 21, Yoshida further discloses that the processor compares the software identifier stored on the removable storage device to the software identifier stored in the system's storage (col. 6, lines 27-40).

c. Regarding claim 22, Yoshida further discloses that the processor is adapted to execute a program that causes the processor to store additional software identifier in the system's storage that were previously not stored in the system's storage (fig. 9, step S13).

d. Regarding claim 23, Yoshida further discloses that additional software identifier allows installation of one previously unavailable software product stored on the removable storage device (fig. 9, step S15).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 703-306-5617. The examiner can normally be reached on Mon - Fri: 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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MD

Minh Dinh
Examiner
Art Unit 2132

MD
03/16/2004


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